COMMENTS

The enclosed is responsive to the Examiner's Office Action mailed on September 17, 2009. At the time the Examiner mailed the Office Action claims 40-51 were pending. By way of the present response the Applicant has: 1) amended claims 40, 41, 45, 46, 50 and 51; and, 2) has not added or canceled any claims. As such claims 40-51 remain pending. The Applicant respectfully requests reconsideration of the present application and the allowance of claims 40-51.

Rejections Under 35 U.S.C. 112, para. 2

The Examiner has rejected claims 41, 46 and 51 under 35 U.S.C. 112, para. 2 as being indefinite in view of the "Java" limitation that appears in each of these claims. According to the Examiner, "[a] trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name."

The Applicant respectfully disagrees. The term "Java" is understood by those of ordinary skill to refer to a standard <u>specification</u> that defines required <u>structural features</u> of software that is written to be compliant with Java (e.g., classfile structures, method structures, etc.). Thus, the claim limitation "Java" incorporates such <u>structures</u> into the "object oriented runtime framework" recited in claims 41, 46 and 51 as appropriate. Because the "Java" limitation defines <u>structures</u> it has the effect of "identifying a particular product." Therefore, the Applicant respectfully submits that the basis for the Examiner's rejection is nonexistent and should be removed. The Applicant has amended claims 41, 46 and 51 to specify that the object oriented runtime framework is Java compliant.

<u>Rejections Under 35 U.S.C. 103</u>

The Examiner has rejected independent claims 40, 45 and 50 under 35 U.S.C. 103 as

being obvious in view of U.S. Patent No. 6,662,359 ("Berry") and U.S. Patent No. 6,560,618

("Ims"). Each of independent claims 40, 45 and 50 recite:

> providing a user with options for modifying an application's bytecode, said
> application composed of a plurality of archive files, said archive files having
> respective class files, said respective class files having respective methods, said
> options including one or more of the following:
>> i) modifying bytecode of only one classfile within any one of said archive
>> files;
>> ii) modifying bytecode of only one method within only one of said archive
>> files' respective classfiles;

According to the Examiner, Berry meets all the limitations described above with the

exception that Berry does not disclose archive files specifically. The Examiner introduces

Ims to modify the disclosure of Berry to include the missing archive files feature.

As the Applicant understands Berry, Berry discloses a web browser that modifies the

byte code of all class files that are received from a network via the web browser. Berry

states (emphasis added):

> Java class files are often downloaded from a network, such as the Internet. The
> method of the present invention may be practiced on any Java class file, regardless
> of how the class file is obtained. If the class file is obtained from a network, such as
> the Internet, it is typically loaded immediately into the Jvm and executed. Such Java
> class files are not usually saved on the user's hard disk or in a file system. In some
> cases (e.g., embedded systems), there may not be a hard disk or local file system
> available. Class files downloaded from a network are typically loaded directly into
> memory by the Jvm ClassLoader. Therefore, it is necessary to intercept the class file
> at the loader and transform its memory image directly. <u>This is accomplished by
> modifying a web browser so that it dynamically modifies class files coming from the
> network, as described below with reference to FIG. 3. In the described
> embodiment, the web browser is also a Java file, and thus the same method used to
> modify the web browser is used to modify downloaded Java class file.</u> Also note
> that the method of the present invention works even with Java files containing a
> security signature, as the method of the present invention is used after the security
> signature verification.
>
> The method of the present invention may be used to modify the web browser. For
> example, a Java enabled web browser includes Java Runtime class files, which are
> used to run Java applets coming across the network. <u>The Java Runtime is modified,</u>

> using the method of the present invention so that it provides functionality to
> modify *all* class files that the Runtime loads across the network for subsequent
> execution. In other words, the method of the present invention is invoked twice--
> first, to modify the web browser, and second to cause the web browser to modify a
> downloaded class file.
> Berry, Col. 4, line 59 to Col. 5, line 23.

The above citation discloses that all classfiles downloaded from a network are modified. Col. 7, lines 5-11 of Berry appear to disclose that only some of the methods within a classfile may be modified ("Selective instrumentation is possible if only some of the methods are to be instrumented. In the described embodiment, an inclusion/exclusion list is used to specify which methods are to be instrumented"). Thus Berry appears to disclose – at most – that *all* classfiles downloaded from a network are modified but less than all of the methods within the downloaded classfiles need be modified.

As the Applicant understands Ims, Ims describes the reception of archive files from a network through a web browser. See, e.g. Ims, Fig. 4, box 455 and corresponding discussion. Thus, the Examiner's theory of rejection appears to be that the combination of Berry and Ims discloses the modification of *all* classfiles within an <u>archive file</u> that is received from a network.

Scrutiny of the Applicant's claim limitations reveal that even if the Examiner's combination is applied, the Examiner's combination does not meet each and every claim limitation of independent claims 40, 45 and 50. The claim limitations at issue are recited again immediately below:

> providing a user with options for modifying an application's bytecode, said
> application composed of a plurality of archive files, said archive files having
> respective class files, said respective class files having respective methods, said
> options including one or more of the following:
>> i) modifying bytecode of only one classfile within any one of said archive
>> files;
>> ii) modifying bytecode of only one method within only one of said archive
>> files' respective classfiles;

As discussed at length above, the Examiner's combination only seems to disclose that all classfiles within an archive file received from a network are modified but less than all of the methods within these classfiles need to be modified.

Thus, even if Berry is modified with the archive files of Ims, the combined disclosure cannot meet "modifying bytecode of only one classfile within any one of [the] archive files" where "[the] archive files [have] respective classfiles" because these limitations together indicate that less than all classfiles within an archive file are modified, whereas, as discussed above, the Examiner's combination at best only discloses that all classfiles within an archive file must be modified.

For similar reasons the modification of Berry with the archive files of Ims cannot disclose "modifying bytecode of only one method within only one of said archive files' respective classfiles" where "[the] archive files [have] respective classfiles" because, again, these limitations together indicate that less than all classfiles within an archive file are modified, whereas, as discussed above, the Examiner's combination at best only discloses that all classfiles within an archive file must be modified.

CONCLUSION

In light of the comments above, the Applicant respectfully requests the allowance of all claims.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of this application, the Examiner is invited to contact Robert B. O'Rourke at (408) 720-8300.

Respectfully submitted,

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Dated: December 18th, 2009   /Robert B. O'Rourke/
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